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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,964	07/30/2001	Herbert Martin Wilson	N1205-012	9384

6449 7590 01/15/2003

ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 01/15/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,964

Applicant(s)

WILSON ET AL.

Examiner

Georgia L. Helmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

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DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated October 3, 2002, paper number 7.
2. Applicant has amended claims 35, 37 and 42. Claims 35-43 are pending, and are examined in the instant action. Claim 43 was not included in the previous office action because of a typographical error. This oversight is corrected here.
3. Applicant's amendment to the specification, paper No 7, has not been entered because of a lack of information about the page number or line number.
4. Applicant's Terminal Disclaimer, paper No 8, and has been entered.
5. Applicant's substitute specification, paper No 9, is acknowledged, but it is not entered. The substitute specification needs to be accompanied by a marked-up copy of the specification with all amendments to the specification indicated. These substitute specifications should not include any claims. This substitute specification should also be accompanied by a statement that no new matter has been added.
6. This action is made FINAL necessitated by Applicant's amendment.
7. All rejections not addressed below have been withdrawn.
8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112 second paragraph

9. Claims 35-43 are rejected under 35 U.S.C. 112, second paragraph. This is necessitated by Applicant's amendment.

Claim 35, 37 and 42 should be a method for producing a transformed corn plant, because transformed plants are what is produced by the method. As it stands, Claim 35, 37 and 42 are drawn to a method of transforming a tissue of corn and claims 38 and 43 are drawn to a method of transforming a line of corn.

In claim 37, for clarification, "stock" should be inserted after the third "Agrobacterium" recitation.

In claim 35 (c), "resulting tissue" lacks antecedent basis; it is unclear what step results in "resulting tissue".

In (e), "said growing Type II callus" lacks antecedent basis.

Claims 38 and 43 remain rejected because of the term "gene", for reasons of record.

Claim 42 remains rejected because the "heat shock treatment" conditions are unclear. How is this carried out? Heat shock treatments for bacteria are known in the art, but not for plants.

Claim Rejections - 35 USC § 112-first

10. Claims 35-42 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 35 (a): Applicant has amended "gene" to recite "genetic element". The recited "genetic element" is broader than "gene", is new matter, and is not supported by the specification as originally filed.

In claim 37 (a) and 42 (a): Applicant has amended "gene" to recite "genetic factor". The recited "genetic factor" is broader than "gene", is new matter, and is not supported by the specification as originally filed.

This is a new rejection, necessitated by Applicant's amendment.

Claim Rejections - 35 USC § 102

11. Claims 35, 38, 39, and 40 remain rejected under 35 U.S.C. 102(e) as being anticipated by Hansen, G. (US # 6,162,965) filed June 2, 1997, issued December 19, 2000, for reasons of record.

- Applicant traverses, stating primarily that Hansen, cited by the Examiner, does not disclose or suggest using 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at

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15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a prima facie case of obviousness.

Applicant's traversal has been considered and is unpersuasive because

Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide.

Therefore the rejection is maintained.

Claim Rejections - 35 USC § 103

12. Claims 35, 36, 37, 38, 39, 40, and 41 remain rejected over Hansen, G. (US # 6,162,965), Bhojwani, SS et al (Developments in Crop Science, vol 5, pp 24-41, 198), Holton (US 5,948,955), and Applicant's admitted prior art, for reasons of record.

- Applicant traverses, stating primarily that the cited references, when viewed separately or in combination, do not teach or suggest the claimed invention.

Applicant's traversal has been considered and is unpersuasive because the combination of references properly renders the claimed invention *prima facie* obvious, for reasons of record. This rejection is maintained because Applicant has provided no evidence to support the allegation.

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- Applicant traverses, stating primarily that the Examiner has used an impermissible "obvious to try" standard in reaching the conclusion that Applicant's invention is obvious.
Applicant's traversal has been considered and is unpersuasive because Applicant has provided no evidence that the Office used an "obvious to try" standard.
- Applicant traverses, stating primarily that none of the references cited by Examiner disclose or suggest using 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide. And that therefore, there is not a prima facie case of obviousness.
Applicant's traversal has been considered and is unpersuasive because Applicant's argument is not commensurate in scope with the claims. None of the claims recite the combination of 19 degree C temperature for co-cultivation with using Agrobacterium 1-2 days after rescue from glycerol stocks, an antibiotic at 15-75 mcg/L and a plant growth medium comprising a monosaccharide.
Therefore the rejection is maintained.

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- Applicant traverses, stating primarily that Examiner has randomly picked bits or prior art references using the hindsight reasoning provided by Applicant's disclosure.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence as to why Applicant believes the Office has used hindsight reasoning.

- Applicant traverses, stating primarily that the Examiner's imputed conclusion of obviousness could only have been reached with the benefit of the hindsight application of the teachings of the present specification.

Applicant's traversal has been considered and is unpersuasive because

Applicant has provided no evidence that the Office has used hindsight, as discussed above.

Accordingly, these rejections are maintained.

REMARKS

13. No claims are allowed.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

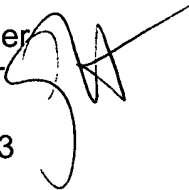
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

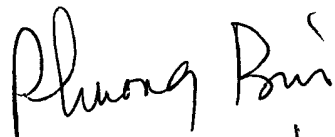
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
January 12, 2003




PHUONG T. BUI
PRIMARY EXAMINER 1/13/03